

*Amendment and Response*  
*Serial No. 09/771,526*

### REMARKS

The undersigned attorney thanks Examiner Wong for his time and courtesy extended during the telephonic interview with him on September 20, 2005. Applicant appreciates the helpful comments made by the Examiner and hereby amends independent claim 1 consistent with the discussions during the interview.

Before entry of this Amendment and Response, the status of the application according to the pending Office action is as follows:

- Claims 1, 3-12, and 24-27 are rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement.
- Claims 1, 3-7, 9-12, and 24-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over International Patent Publication Number WO 95/09034 to Mills (hereinafter "Mills"), in view of U.S. Patent No. 4,154,789 to Delacoste (hereinafter "Delacoste") and U.S. Patent No. 5,688,192 to Aoyama (hereinafter "Aoyama").
- Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills in view of Delacoste, Aoyama, and U.S. Patent No. 5,091,265 to Kennedy et al. (hereinafter "Kennedy").

Applicant hereby amends claim 1, as shown in the preceding Listing of Claims. Support for the amendment may be found in the specification as filed, and at least in Paragraphs [0018] - [0025], [0035], [0044]-[0051], and FIG. 1 of the specification, as published. No new matter has been added thereby.

In view of the above amendment and following remarks, Applicant respectfully requests reconsideration and withdrawal of all grounds of rejection, and passage of claims 1, 3-12, and 24-27 to allowance.

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1. Claims 1, 3-12, and 24-27 are rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement. Applicant respectfully traverses this rejection as applied to the claims, as amended.

Applicant has amended independent claim 1 to recite a top layer complex that *"comprises a plurality of pre-bonded layers forming an inseparable layer."* Support for this amendment may be found in the specification as filed, and at least in Paragraphs [0018]-[0025] and [0044]-[0048].

Generally, the specification as filed describes the methods and advantages of forming a top layer complex of multiple layers, including a syntactic foam, prior to applying the top layer complex to the remaining layers of the ball. See, for example, FIG. 1 and paragraphs [0035]-[0040]. For example, one advantage of the invention is that by creating a top layer including markings that are sealed within the layer *"the markings are extremely resistant to abrasion against friction forces occurring within the outer skin"* (see paragraph [0025]). This is achieved by, for example, creating a top layer complex from a plurality of layers (including a transparent outer layer 22, a printed markings layer 24, a middle layer 26, a syntactic foam layer 50, an adhesive layer 28, and a backing layer 30), a number of which are applied in liquid form and cured in an oven to produce a particularly intimate or inseparable bond between the layers (see paragraphs [0025], and [0044]-[0048]). Bonding the layers in this way allows the resultant plurality of layers to *"behave[] in such a way, with regard to its elastic properties, as if it were made of only one layer."*

After the top layer complex has been *"pre-bonded"* in this manner, to create a layer from a plurality of materials that acts, with regard to its elastic properties, as if it were made of only one layer, the top layer complex is bonded to the middle layer complex and backing layer

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complex, using natural latex or other appropriate material, to produce the individual ball elements. See paragraph [0050] “[1]he top layer complex 20 thus obtained is then bonded to the middle layer complex 13 and the backing layer complex 12.”

As such, amended independent claim 1 complies with the written description requirement of 35 U.S.C. § 112 and is parentable. Because claims 3-12 and 24-27 depend either directly or indirectly from amended independent claim 1, these claims are patentable as well. Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejection of claims 1, 3-12, and 24-27 under 35 U.S.C. § 112.

2. Claims 1, 3-7, 9-12, and 24-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills in view of Delacoste and Aoyama. Applicant respectfully traverses this rejection as applied to the claims, as amended.

Briefly, Mills appears to disclose a sports ball 10 having an inflatable bladder core 11 covered by a reinforcing cloth structure 12, which is in turn covered by a polyethylene foam layer 13. This foam layer is covered by an exterior covering 14, composed of a transparent film, which is laminated onto the foam layer 13. Decorative markings 15 are applied to the inward facing side of the exterior covering prior to lamination (See Mills, page 9, lines 15-30).

Applicant's amended independent claim 1 describes a finished ball including a “*top layer complex comprise[ing] a plurality of pre-bonded layers forming an inseparable layer that includes a syntactic material that comprises a plurality of resilient spherical bodies dispersed in a matrix material.*” Applicant respectfully submits that Mills fails to teach or suggest such a structure, but rather appears to teach a ball having a top layer comprising a single layer of transparent film with markings applied to the lower surface of this film. Further, Mills fails to teach or suggest a top layer complex including a syntactic material comprising a plurality of

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resilient spherical bodies dispersed in a matrix material, but rather teaches a single top layer that does not contain any material comprising a plurality of resilient spherical bodies. As such, Mills fails to teach or suggest each and every element of Applicant's independent claim 1.

Aoyama and Delacoste fail to cure the deficiencies of Mills. Briefly, Aoyama appears to disclose a golf ball 1 having a single or multiple layered core 2 with a discrete cover 3, typically of a thermoplastic material such as SURLYN or balata rubber, molded over the core (See Aoyama column 2, lines 11-20 and column 4, lines 45-50). As such, Aoyama appears to teach an outer layer comprising a single layer of thermoplastic material. Delacoste appears to disclose a ball having an outer thermoplastic layer 6 formed in a ball shaped mold 1, 2, and 3, which surrounds one or more internal layers introduced into the molded outer layer 6. (See Delacoste column 6, line 64 to column 7, line 52). As such, Delacoste appears to teach an outer layer comprising a single layer of thermoplastic material. Therefore, neither Mills, nor Delacoste, nor Aoyama, alone or in proper combination, teaches or suggests a finished ball including a "*top layer complex comprise[ing] a plurality of pre-bonded layers forming an inseparable layer that includes a syntactic material that comprises a plurality of resilient spherical bodies dispersed in a matrix material.*" As such, amended independent claim 1 is patentable. Because claims 3-7, 9-12, and 24-27 depend, either directly or indirectly, from independent claim 1, these claims are patentable as well.

Accordingly, reconsideration and withdrawal of the rejection of claims 1, 3-7, 9-12, and 24-27 under 35 U.S.C. § 103(a) based on Mills in view of Delacoste and Aoyama are respectfully requested.

3. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills in view of Delacoste, Aoyama, and Kennedy. Applicant respectfully traverses this rejection as applied to

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the claims, as amended.

As stated above, Mills in view of Delacoste and Aoyama, fails to teach or suggest each and every element of Applicant's independent claim 1, from which claim 8 depends. Kennedy fails to cure the deficiencies of Mills in view of Delacoste and Aoyama. Kennedy fails to teach or suggest a finished ball including a ***"top layer complex comprise[ing] a plurality of pre-bonded layers forming an inseparable layer that includes a syntactic material that comprises a plurality of resilient spherical bodies dispersed in a matrix material,"*** as recited by amended independent claim 1.

Because claim 8 depends indirectly from independent claim 1, this claim is patentable as well. Accordingly, reconsideration and withdrawal of the rejection of claim 8 under 35 U.S.C. § 103(a) based on Mills in view of Delacoste, Aoyama, and Kennedy is respectfully requested.

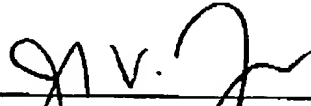
#### CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration, withdrawal of all grounds of rejection, and allowance of claims 1, 3-12, and 24-27 in due course. The Examiner is invited to contact Applicant's undersigned representative by telephone at the number listed below to discuss any outstanding issues.

Respectfully submitted,

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